## III. REMARKS

### Status of the Claims

Claims 1 is amended and new claim 15 is added. Claims 1-15 are presented for further consideration.

### Summary of the Office Action

Claims 1-14 stand rejected under 35USC103(a) based on the reference Rivette, U.S. Patent No.5,623,679 in view of the reference Warnock, et al, U.S. Patent No. 5,634,064. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

### Discussion of the Cited References

The Examiner now relies primarily on the reference Rivette to support the rejection based on obviousness. The substance of the disclosure of Rivette is described concisely in the abstract, as follows:

> "In the Preferred embodiment of the present invention, text and image files for documents, such as for example patent documents, are initially stored on separate magnetic tape media. These data files are extracted from the respective tapes and placed onto a faster medium, such as a hard disk drive. The text and image files are synchronized to produce Equivalent Files using heuristic algorithms to create an approximate equivalence relationship between the text and the image files. The Equivalent Files and image files residing on, for example, a hard disk drive or compact disk (CD), are coupled as a resource to a computer display system. The graphic user interface of the present invention permits the user to display, manipulate, and edit the Equivalent File created using the process of the present invention, and to simultaneously view the image file on the display."

The display of Rivette, therefore, is divided into a image file and a text file, not the navigation pane and read pane of the subject application.

The system of the subject application is directed to a solution for the problem of viewing large HTML files on a small screen. It provides a means by which a full page can be viewed on a navigation screen and permits the scrolling and selection of small portions of the page with start and end elements defined according to language rules. The language rules relate to the syntax of written language, for example punctuation, conjunctives, and connecting parts of sentences. An enlarged version of the small portions selected in this manner are viewed on an associated display. This is clearly described in independent claims 1,7,14, and new claim 15.

There is nothing in the 116 pages of the reference Rivette that deals with this problem. The Examiner extrapolates from bits and pieces of the disclosure of Rivette to obtain some relationship to the subject application. For example, Examiner states:

> "**Figure 10 illustrates a preprocessing of pages in order to display the text portion to a user for a method of extracting, synchronizing, displaying, and manipulating text and image documents in electronic form**"

The examiner likens this to the claim limitation "preprocessing the pages in order to display the text portion in them". Clearly the Examiner is dismantling the claims and not considering them in their entirety. Out of

the context of the claim this excerpt could be considered to describe any computer screen display driver.

The Examiner continues by characterizing the disclosure of Rivette, as follows:

**"Figure 30 illustrates a display divided into a navigation pane and a read pane"**

This is not supported by the text. The disclosure of Rivette at column 34, lines 12-27 indicates that the display is divided between an image (graphic) file and a text file, both of which provide navigation.

It is well settled that the examination process should consider the claims as a whole. Yet the Examiner persists in considering the claims, limitation by limitation, and comparing them to bits and pieces of the cited reference without the benefit of the context of either.

Further evidence of the clipped nature of the Examiner's reasoning is the reference to the words "overall view" as being unclear and failing to distinguish. The full phrase in question is "placing an overall view of at least one decoded page to the navigation pane;". This considered with the description of the read pane most definitely distinguishes over the cited reference Rivette.

The Examiner indicates that the arrow keys and drop down menus shown in figure 31 provide for searching for new start and end elements. The text relating to figure 31, at column 34, lines 28-67 indicates that these are scrolling

tools and may be used for that purpose. There is no
indication of scrolling based on start elements and end
elements governed by rules of language. In fact there is
no mention of any start or end elements in any context.
The Examiner appears to speculate that a user of this
scrolling feature may use the tools to scroll according to
any method. This does not teach the searching of text
based on language specific rules.

The present invention relates to reading text on hypertext
pages received usually from a network. As known, such
pages intrinsically may contain links to other pages. The
documents being read by the system of Rivette are not in
the form of hypertext, and the whole system has no network
connection. The links of the Rivette system are
constructed in a separate database and are not included in
the original pages to be read.

The Examiner refers to figure 36 of Rivette with regard to
claims 2 and 3, contending that the user can base the start
element and end element on punctuation mark, number, etc.

Figures 35 and 36 is described in the text of the reference
Rivette, see column 36, lines 17-39, as illustrating a find
function by which text from the image screen may be located
on the text screen. In such a tool the finding of a
language feature such as period or comma, would defeat the
purpose of the tool. It would be no better than scrolling
through the entire document word by word until something
matched. There is no indication that this tool could be
used to find a start element and an end element based on
language rules for determining the excerpt form the

10

navigation screen which is to be displayed on the read screen.

The Examiner relies on the disclosure of Rivette as disclosing all of the limitations of the claims, but fails to explicitly state searching for a new start element and end element if a shift element is received. As indicated above this is a considerable exaggeration of the disclosure of Rivette. Nevertheless the Examiner cites the reference Warnock for this final piece in support of the obviousness rejection. The examiner refers to a scrolling mechanism of Warnock and characterizes as follows:

> **"The scrolling mechanism provides a similar result as that of a search for new start element and end element if a shift command is received."**

Applicant submits that there is nothing in the disclosure of Warnock to support this. The cited reference Warnock describes a system by which publications may be presented in a variety of viewing modes on a display screen of a personal computer. Throughout the document only one viewing mode is available at one time. The text of the Warnock reference is primarily directed to selecting portions of the text for linking. For example, in a newsletter having multiple articles the text of which is not presented in a contiguous manner, but is interrupted by advertisements or other articles, an article beginning on page 1 and ending on page 6 can be linked and presented in a different viewing mode as a continuous article (see column 2, lines 9-25). There is no provision for placing an overall view of a page in a navigation pane, selecting a

11

portion of the display in the navigation pane and then
presenting the selected portion in a read pane.

The Examiner is reminded that the purpose of searching for
a start element and an end element based on language
specific rules, according to this invention, is to define
limited material for display in the read pane. The
Examiner's citation of a normal scrolling function is
irrelevant and out of the context of this invention. The
Examiner dismisses the term "language specific rules" as a
distinguishable feature by indicating that it can be found
in the illustration of a patent in the reference Rivette.
This is unclear and unsupportable.

**The Issue of Obviousness**
It is well settled that in order to establish a prima facie
case for obviousness, the prior art reference (or
references when combined) must teach or suggest all the
claim limitations. The teaching or suggestion to make the
claimed combination and the reasonable expectation of
success must both be found in the prior art, without
reference to the disclosure of this application.

The reference Rivette does not teach dividing the display
into a navigation pane and a read pane, nor does it mention
anything about searching for start elements and end
elements based on language rules. Warnock does not remedy
these deficiencies. Applicant submits that the modification
of the teachings of Rivette and Warnock in order to obtain
the invention, as described in the claims submitted herein,
would not have been obvious to one skilled in the art.

12

Also, there is no indication that such a modification would be desirable.

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

> **"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."**

The above arguments apply equally to the rejected dependent claims and to new claim 15.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.
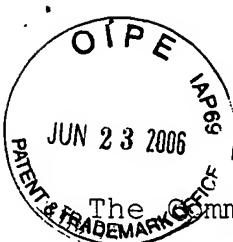
Respectfully submitted,

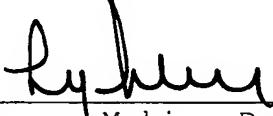Geza G. Ziegler, Jr.
Reg. No. 44,004

20 June 2006
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT    06824
(203) 259-1800
Customer No.: 2512

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA   22313-1450

Date: 20 June 2006     Signature: _____
Person Making Deposit